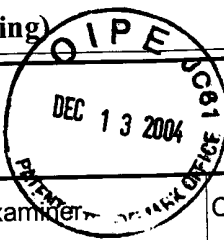


**TRANSMITTAL LETTER
(General - Patent Pending)**

Docket No.
7208-77901-1

In Re Application Of: **R. Mark Halligan**



Application No.
09/757,206

Filing Date
01/09/2001

Examiner
Mooneyham, Janice A.

Customer No.
24628

Group Art Unit
3629

Confirmation No.
1306

Title: **METHOD AND APPARATUS FOR DOCUMENTATION, ANALYSIS, AUDITING, ACCOUNTING,
PROTECTION, REGISTRATION, AND VERIFICATION OF TRADE SECRETS**

COMMISSIONER FOR PATENTS:

Transmitted herewith is:

**Summary of Interview
Postcard Receipt**

in the above identified application.

- ☒ No additional fee is required.
- ☐ A check in the amount of _____ is attached.
- ☒ The Director is hereby authorized to charge and credit Deposit Account No. **23-0920**
as described below.
- ☐ Charge the amount of _____
- ☒ Credit any overpayment.
- ☒ Charge any additional fee required.
- ☐ Payment by credit card. Form PTO-2038 is attached.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Signature

**Jon P. Christensen
Reg. No. 34,137**

Dated: **December 10, 2004**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on

12/10/2004

(Date)

Signature of Person Mailing Correspondence

Abby Boone

Typed or Printed Name of Person Mailing Correspondence

CC:



AP A 3629
JW

77901-1

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: R. Mark Halligan Art Unit: 3629
Serial No.: 09/757,206
Filed: January 9, 2001
For: METHOD AND APPARATUS FOR DOCUMENTATION,
ANALYSIS, AUDITING, ACCOUNTING, PROTECTION,
REGISTRATION, AND VERIFICATION OF TRADE
SECRETS
Attorney
Docket No.: 77901-1

SUMMARY OF INTERVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-0001

Sir:

On November 10, 2004, inventor Mr. Richard Weyand and the below signing attorney Jon P. Christensen interviewed Examiner Jan Mooneyham and her supervisor Mr. John G. Weiss. The substance of the interview is as follows:

- 1) Applicant described in detail the concept of the invention, its proper use, and its benefits. Applicant answered several questions from PTO representatives regarding the concept, use and benefits of the invention.
- 2) PTO representatives stated that the system claims of 09/757206 were a problem, because 1) the physical system

claimed is no more than a generic computer, and 2) the user is required to participate in the invention. Method claims were therefore more appropriate.

3) PTO representatives stated that the phrase "generally accepted legal criteria" is vague, because "generally accepted legal" is something of an oxymoron: lawyers can argue about anything. They asked if incorporating the six factors from the First Restatement of Torts directly, rather than use the generic term, would weaken the invention. Applicant responded that, since the six factors from the First Restatement of Torts is the only "generally accepted legal criteria" for trade secrets at this time, and that would be unlikely to change during the lifetime of the patent, that this change would not unduly weaken the claim.

4) PTO representatives stated that the method claims of 09/757940 were non-patentable subject matter as written, because a mere idea is not patentable subject matter and the claims as written are non-technical, that is, they do not advance the technical arts. The claims must incorporate the use and advance of technology. Applicant noted that Barney (6556992), cited as anticipatory to claim 1, had similar language, but specifically included the use of a computer in the claims.

5) Applicant identified to PTO representatives various places in the specification that constituted enablement in response to each of Examiner's specific concerns in the non-final rejection regarding failure to comply with the enablement requirement of 35 U.S.C. 112 first paragraph.

These portions of the specification seemed to satisfy PTO representatives as to enablement in the context of a method claim.

Specifically, with regard to 09/757206, applicant responded to the following questions and statements:

a) "What is the means for doing the calculation (of the security measures factor)?".

The security measures factor is a weighted value of security measures in place for the trade secret, as discussed on the bottom of page 17 and top of page 18 of the application. "Weighted" is a well-known term of art in mathematics and accounting. The weights are assigned in the judgment of the system/method user.

b) "How is the net present value of a trade secret calculated?"

The net present value of a trade secret is calculated as discussed in the first full paragraph of page 32 of the application.

c) "How is the economic benefit factor calculated?"

The economic benefit factor is an assigned value, as discussed in the second full paragraph of page 20 of the application.

d) "How does one characterize whether the trade secret constitutes negative know-how?"

Part of the data entered for each trade secret identifies whether or not the trade secret constitutes

negative know-how, as discussed in the second full paragraph of page 17 of the application.

e) "The applicant has failed to provide the mathematical equations used to perform calculations (of the weighted values of the six factors)".

Various calculations are illustrative in evaluating trade secrets using the system/method. Two examples are provided in the first full paragraph of page 24 of the application.

f) "How are the security threats factors calculated?"

The security threat factor is a weighted value of security threats anticipated for the trade secret, as discussed in the first full paragraph of page 18 of the application. "Weighted" is a well-known term of art in mathematics and accounting. The weights are assigned in the judgment of the system/method user.

Specifically, with regard to 09/757940, applicant responded to the following questions and statements:

a) "What are the values and how are they assigned?".

Assignment of the values is discussed in the second full paragraph of page 20 of the application. An example of one set of criteria for the assignment of values is included in Table C beginning on page 20 of the application.

b) "How is the one or more metrics generated?"

Two examples of calculations of the metrics are provided in the first full paragraph of page 24 of the application.

c) "What are the logical and mathematical processes used to determine the metrics?"

Two examples of calculations of the metrics are provided in the first full paragraph of page 24 of the application.

d) "What is the predetermined threshold value by which the comparison is made?"

Threshold values are determined based on experience and the needs of the user.

e) "How is the application fingerprint created?"

Creation of the application fingerprint is discussed on the bottom of page 39 and the top of page 40 of the application.

6) Applicant identified to PTO representatives various places in the specification that constituted distinctly claiming the subject matter in response to each of Examiner's specific concerns in the non-final rejection regarding failure to particularly point out and distinctly claim the subject matter as a requirement of 35 U.S.C. 112 second paragraph. These portions of the specification seemed to satisfy PTO representatives as to this requirement in the context of a method claim.

Specifically, with regard to 09/757206, applicant responded to the following questions and statements:

a) "How is the indexing performed...?"

The indexing process is discussed on the bottom of page 16 and the top of page 17 of the application.

b) "...how are the trade secret drafts converted into trade secret applications?"

The conversion process is discussed on the top of page 17 of the application.

c) "How are the security measures specified?"

The method of specifying the security measures is discussed on the bottom of page 17 of the application.

d) "How are security threats specified?"

The method of specifying the security threats is discussed in the first full paragraph of page 18 of the application.

e) "What are the six factors of a trade secret enumerated in Section 757 of the First Restatement of Torts."

First, the six factors are enumerated within Table C beginning at the bottom of page 20 of the application. Second, "the six factors of a trade secret enumerated in Section 757 of the First Restatement of Torts" is well-defined, as there is and can be only one First Restatement of Torts, it contains only one Section 757, and Section 757 contains only one enumeration of six factors with regard to trade secrets. Third, "the six factors of a trade secret enumerated in Section 757 of the First Restatement of Torts" is a term of art well understood by those of average knowledge of the art of trade secret law.

f) "How are the values weighted?"

In context it refers to the values for the six factors. "Weighted" is a well-known term of art in mathematics and accounting. The weights are assigned in the judgment of the system/method user, as discussed in the last full paragraph of page 20 of the application.

g) "What is a combinational trade secret?"

Combinational trade secret is defined in the second full paragraph of page 17 of the application. Also, "combinational trade secret" is a term of art well understood by those of average knowledge of the art of trade secret law.

h) "What constitutes negative know-how?"

Negative know-how is defined in the third full paragraph of page 4 of the application. Also, "negative know-how" is a term of art well understood by those of average knowledge of the art of trade secret law.

i) "How does one create a specification of the type trade secret using alphabetic, numeric, or alphanumeric fields?"

The use of alphabetic, numeric, or alphanumeric fields to specify the type of trade secret is discussed in the first full paragraph of page 31 of the application.

Specifically, with regard to 09/757940, applicant responded to the following questions and statements:

a) "What are 'generally accepted legal criteria'?".

The specific use of the six factors of a trade secret from the First Restatement of Torts is not significantly limiting as compared to the general description 'generally accepted legal criteria' for a trade secret, and will be substituted.

b) "What does the applicant mean by 'creating an application fingerprint from a content of the trade secret'?"

The creation of the application fingerprint is discussed on the bottom of page 39 and the top of page 40 of the application.

c) "What is an 'application fingerprint'?"

Application fingerprint is defined on the bottom of page 39 of the application.

d) "...what is a 'content of the trade secret'?"

The content of the trade secret is defined on the bottom of page 39 of the application.

e) "What is a 'deterministic one-way algorithm'?"

'Deterministic', 'one-way' and 'algorithm' are terms of art in the computer processing field. 'Deterministic' means that a computation will have the same result every time it is performed. 'One-way' means that, given the output of the computation, the inputs of the computation cannot be determined, that is, the computation cannot be reversed. 'Algorithm' is defined as a precise set of rules for how to solve a problem. Thus, a 'deterministic one-way algorithm' for creating an application fingerprint means a precise set of rules for creating an application

fingerprint that, for the same input data, will yield the same result every time it is performed, and cannot be reversed in order to calculate the input data given only the output data.

f) "How is the 'certificate fingerprint' created from the application fingerprint?"

The creation of the certificate fingerprint is discussed in the second paragraph of page 40 of the application.

g) "What are the 'six factors of a trade secret set forth in Section 757 of the First Restatement of Torts'?"

First, the six factors are enumerated within Table C beginning at the bottom of page 20 of the application. Second, "the six factors of a trade secret enumerated in Section 757 of the First Restatement of Torts" is well-defined, as there is and can be only one First Restatement of Torts, it contains only one Section 757, and Section 757 contains only one enumeration of six factors with regard to trade secrets. Third, "the six factors of a trade secret set forth in Section 757 of the First Restatement of Torts" is a term of art well understood by those of average knowledge of the art of trade secret law.

h) "...none of the steps comprise the protecting of a trade secret."

Protection of trade secrets from theft, especially theft by insiders such as employees to whom the trade secret must be revealed if they are to perform their job duties, is best achieved through a credible threat of litigation in the courts. Successful litigation requires

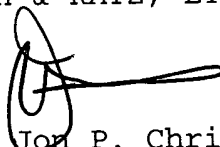
proper documentation of the trade secret, as well as measures taken to protect its secrecy. Such measures can only be properly applied if the trade secret owner knows what the trade secrets are. Therefore, documentation of trade secrets of the kind provided by the instant invention is a means for protection of trade secrets.

7) PTO representatives noted that the true invention was the method for evaluating trade secrets under the six factors from the First Restatement of Torts. In response to a direct query from Applicant, PTO representatives affirmed that the invention of the specification was in their opinion patentable subject matter, and that it was simply a matter of correct claim language.

The allowance of claims 1-95 as now presented, is believed to be in order and such action is earnestly solicited. Should the Examiner be of the opinion that a telephone conference would expedite prosecution of the subject application, he is respectfully requested to telephone applicant's undersigned attorney.

Respectfully submitted,
WELSH & KATZ, LTD.

By



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December 10, 2004
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